UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/643,321	08/21/2000	Michael C. Chen	1844030102CIBT- P01 - 513	9007

7590 04/19/2004

BARTON E. SHOWALTER, ESQ.
BAKER BOTTS L.L.P.
2001 ROSS AVENUE
SUITE 600
DALLAS, TX 75201-2980

EXAMINER	
GEREZGIHER, YEMANE M	
ART UNIT	**PAPER NUMBER**
2144	18

DATE MAILED: 04/19/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/643,321	Applicant(s) CHEN ET AL.
	Examiner Yemane M Gerezgiher	Art Unit 2144

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *29 January 2004*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-32* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-32* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *22 March 2002* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. Amendment A, received on 01/29/2004 has been entered. Claims 1-32 remain pending in this application.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> **The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.**

3. Claims 1-32 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Amended claims 1, 15 and 23, recite, "... the memory unit operable to store information at the first station and to determine when to play the information, the playback module for playing the information stored at the first station in accordance with the determination of the memory unit, and ..." (See Page 2, Claim 1, Claim Lines 8-11; Page 5, Claim 15, Claim Lines 6-9 and Page 7) and "storing information at the first station using the memory unit; determining at the memory unit when to play the

information; and playing the information using the playback module in accordance with the determination of the memory unit (See Page 7, Claim 23, Claim Lines 11-14)

The specification of the invention does not set forth a memory unit been operable to determine when to play a voice data and playing the voice/data using a playback module.

Patent law requires that applicant must disclose his invention in such detail that it will not require undue experimentation for one skill in the art. Applicant did not comply this requirement of the first paragraph. The examiner contends that it would require undue experimentation for one of ordinary skill in the data processing art to make and use the claimed invention for the reasons set forth hereinabove. Applicant is reminded that no new matter is allowed in the amendment to the specifications under 35 U.S.C. 132 and 37 CFR 1.118(a).

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> **The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.**

5. Claims 1-32 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Amended claims 1, 15 and 23, recite, "... **the memory unit** operable to store information at the first station **and to determine when to play the information**, the playback module for playing the information stored at the first station in accordance with

the determination of the memory unit, and ..." (See Page 2, Claim 1, Claim Lines 8-11; Page 5, Claim 15, Claim Lines 6-9 and Page 7) and "storing information at the first station using the memory unit; **determining at the memory unit when to play the information**; and playing the information using the playback module in accordance with the determination of the memory unit (See Page 7, Claim 23, Claim Lines 11-14).

A memory unit is a data storage that may hold computer readable information data or executable programs comprising modules/functions in order to process a task(s). Having said that, it is unclear how storage unit or a memory unit is *operable to determine when to play* a voice or other form of information using a *playback module.* Only a module or a process (a program in execution) residing in a memory unit may determine a condition of some kind. Thus, it is unclear how a memory determines when to play the audible data.

For examination purpose, the Examiner will broadly interpret the amendment made to the claims to read "the first device comprising a memory unit operable to store information and a playback module to play the information stored in the memory unit".

Response to Arguments

6. Applicant's arguments filed 02/05/2004 have been fully considered but they are not persuasive.

Applicants traverse the Official Notice taken by the Examiner requiring the Examiner to produce evidence that indicate the use of a memory unit and a playback module at the

time the invention was made. The Examiner herein presents the following references in support of the Official Notice taken in the first action of this application.

Didcock (U.S. Patent Number 6,396,907) disclosed a playback control module and a memory unit resident in client computer playing either multimedia-based or telephone-based message playback operations. **See Column 6, Line 47 through Column 7, Line 27; and Figures 3, 4 and 5.**

Tarlow et al (U.S. Patent Number 5,045,327) disclosed a digital recording and playback module system where the playback module must reside in a memory (inherent future) operable to play a recorded voice. **See ABSTRACT.**

Kaufman (U.S. Patent Number 6,654,367) disclosed an Internet audio application having voice memory unit and a playback module to play recorded voice information therein. **See ABSTRACT and Figure 2.**

Kaufman (U.S. Patent Number 6,035,018) disclosed a recorder/playback module playing a message stored in a memory unit. **See Column 6, Lines 20-29 and Figures 1 and 2.**

Takahata et al (U.S. Patent Number 6,272,278) disclosed multimedia data storage and a playback scheme by reading information stored in a memory unit and playing the multimedia using a playback module. **See Column 9, Lines 1-11 and Column 10, Lines 33-49.**

A device having a memory unit and a playback module to play information stored in the memory of a device was well known in the art at the time the invention was made.

Thus, the rejection applied based on Official Notice in the first action was proper for the reasons disclosed above.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> **(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.**

8. Claims 1-10 and 12-32 are rejected under 35 U.S.C. 103(a) as being un patentable over Reese (U.S. Patent Number 6,374,237) in view of Engbersen et al (U.S. Patent Number 6,341,304) hereinafter referred to as Engbersen and further in view of Kaufman (U.S. Patent Number 6,654,367)

Reese disclosed a method and system for requesting and receiving information from a remote server connected to a database ***(a database storing information, a server associated with the database having information module responsive to search request signal and sending information from the database corresponding to the search request signal)***. **See Abstract**. Reese showed a client at a station requesting for information from a server connected to a database based on a profile of the user and where the server retrieved information that substantially matched the user's profile provided by the user using a user interface to interact with a device ***(a***

user interface for allowing a user to interact with the first station; and a storage medium having therein a plurality of modules including a call initialization module initiating a communication with a second device) **(see Fig.6, col.5, line 43 through col. 6, line 67)**. Reese disclosed a client at a first station establishing a connection with the server ***(establishing a communication channel between the first station and a server, the server associated with a database)*** and sending personal information to the server where the server was connected to a database retrieving and identifying information based on the users interest categories (claims 30-32) and sending and storing (claims 7, 9 and 24-29) the information at the station providing the client with best matched information from the database storing information based on broad categories (claim 5). **See col.3, lines 24-55**. Reese disclosed the information been advertisements of different types and where the advertisement (for example stock quotation information based on the client's personal interest or user profile) (claims 12-14). See col. 4, lines 2-21 and col.1, lines 41 through col. 2, line 3. Reese disclosed a code module for gathering a user profile (claims 2, 6 and 22), related to the demographics of the user. See Figs. 4, 6 and 9, col.4, lines 37-54 and Patent claims 6 and 14. Reese substantially disclosed the invention as claimed, however, failed to expressly teach a terminal/station having a controller determining available bandwidth between the server and the station and receiving information at the station based on the available bandwidth, or a station having a playback module for playing information stored at the station.

An artisan working with Reese's system at the time the invention was made, would have been motivated to look for arts that may have allowed a specific teaching in determining available bandwidth before requesting to receive/send data from a device to another device. In these arts, Engbersen disclosed determination of bandwidth available when requests for accessing (uploading or downloading) data item were made by network terminals by monitoring the bandwidth to receive data from a source (server or database) (claim 3 and 16), and determining whether information was successfully downloaded and if downloading was interrupted or aborted because of insufficient bandwidth, a request was added for resending (retry to send) the information to a client terminal (claim 4, 18 and 19). See abstract, Figs. 3 and 4, and Column 3, line 65 through Column 4, line 52. However, Engbersen did not specifically mention a station/device having a playback module for playing information stored at memory or storage of the station/device.

Kaufman disclosed an Internet audio application having voice memory unit and a playback module to play recorded voice information therein. See ABSTRACT, Figure 2 and Column 4, Lines 36-58.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to take the teachings of Engbersen related to determination of available bandwidth and have modified Reese related to establishing a voice connection between devices, so that uploading information from a remoter server to a client terminal could be deferred or carried out based on the determined available bandwidth. Further it would have been obvious to take the teachings of Kaufman related

to a memory unit and playback module in a device or station and have modified the combined teachings of Engbersen and Sassin by integrating a playback module in order to play audible information stored in a station.

9. Claims 1-6, 11, 15, 16, 18-25 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sassin et al (U.S. Patent Number 6,249,576) hereinafter referred to as Sassin in view of Engbersen et al (U.S. Patent Number 6,341,304) hereinafter referred to as Engbersen and further in view of Kaufman (U.S. Patent Number 6,654,367)

Sassin disclosed a system and method providing directory information comprising a database and a server associated with the database and where the server was configured to transmit information based on a search request command signal ***(a database storing information, a server associated with the database having information module responsive to search request signal and sending information from the database corresponding to the search request signal*** and ***establishing a communication channel between the first station and a server, the server associated with a database)*** and a first device "initiating a voice conversation" with a second device. See abstract. Sassin disclosed establishing a communication channel between a first device and a second device (claim 25) or a server associated with the device (a station), the device having a graphic user interface ***(a user interface for allowing a user to interact with the first station; and a storage medium having therein a plurality of modules including a call initialization module initiating a***

communication with a second device) for a client of the telephone directory information system where the station/device was a telephonic (claim 11) device having a storage medium and a memory manager managing allocation, de-allocation, sharing and/or use of memory (claims 20, 21 and 24) and where the device could be integrated with a computer device and where the user interface was used to collect information from the user (claims 2, 22 and 30) in order to perform a search request from the server associated with the database (claims 5 and 6). See Figs.1-7, Column 1, line 66 through Column 3, line 60, Column 5, line 12 through Column 6, line 26, and Column 9, lines 5-46. However, Sassin did not expressly teach a device (a station) having a controller determining available bandwidth between the server and the station and receiving information at the station based on the available bandwidth, or a station having a playback module for playing information stored at the station. However for a device to have a playback module for playing back stored information was well known in the art at the time the applicant's invention was made.

An artisan aware of Sassin's invention would have been motivated to look for arts that may have allowed a specific teaching in determining available bandwidth before requesting to receive or send data from a device to another device. In these arts, Engbersen disclosed determination of bandwidth available when requests for accessing (uploading or downloading) data item were made by network terminals by monitoring the bandwidth to receive data from a source (server or database) (claim 3 and 16), and determining whether information was successfully downloaded and if downloading was interrupted or aborted because of insufficient bandwidth, a request was added for

resending (retry to send) the information to a client terminal (claim 4, 18 and 19). See abstract, Figs. 3 and 4, and Column 3, line 65 through Column 4, line 52. However, Engbersen did not specifically mention a station/device having a playback module for playing information stored at memory or storage of the station/device.

Kaufman disclosed an Internet audio application having voice memory unit and a playback module to play recorded voice information therein. See ABSTRACT, Figure 2 and Column 4, Lines 36-58.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to take the teachings of Engbersen related to determination of available bandwidth and have modified Sassin related to establishing a voice connection between devices, so that uploading information from a remoter server to a client terminal could have been deferred or carried out based on the determined available bandwidth. Further it would have been obvious to take the teachings of Kaufman related to a memory unit and playback module in a device or station and have modified the combined teachings of Engbersen and Sassin by integrating a playback module in order to play audible information stored in a station.

10. Claims 1, 3, 11, 15, 16, 18- 20, 22, and 25- 29 are rejected under 35 U.S.C. 103(a) as being un patentable over Jawahar et al (U.S. Patent Number 6,256,620) hereinafter referred to as Jawahar in view of Engbersen et al (U.S. Patent Number 6,341,304) hereinafter referred to as Engbersen and further in view of Kaufman (U.S. Patent Number 6,654,367)

Jawahar disclosed a method apparatus for monitoring information access where therein a server associated with a database storing information ***(a database storing information, a server associated with the database having information module responsive to search request signal and sending information from the database corresponding to the search request signal.*** See Figures 1 and 2. A station/device initiating a voice communication with another station/device where therein a storage and a memory manager at the first storage storing information (claims 20 and 21) (See Column 5, Lines 35-66 and Column 6, Lines 59-66). Jawahar stated that a first device been a telephonic device (claim 11) having a user interface ***(a user interface for allowing a user to interact with the first station; and a storage medium having therein a plurality of modules including a call initialization module initiating a communication with a second device)*** interacting with the device and storage comprising modules connected to the packet switched telephonic network establishing a voice communication with another station or the server ***(establishing a communication channel between the first station and a server, the server associated with a database)***. See Figs. 1 and 2, and col.5, line 35 through col.7, line 14. "Receiving information at the station occurring before or after sep of establishing a communication channel between the stations" (claims 9 and 25-29) was inherently disclosed since the server was connected to the station through a dedicated communication line. See col. 8, lines 6-8. However, Jawahar did not teach a playback module for playing information received at a station and a flow control for determining available bandwidth to receive information at the station.

An artisan aware of Jawahar's invention would have been motivated to look for arts that may have allowed a specific teaching in determining available bandwidth before requesting to receive or send data from a device to another device. In these arts, Engbersen disclosed determination of bandwidth available when requests for accessing (uploading or downloading) data item were made by network terminals by monitoring the bandwidth to receive data from a source (server or database) (claim 3 and 16), and determining whether information was successfully downloaded and if downloading was interrupted or aborted because of insufficient bandwidth, a request was added for resending (retry to send) the information to a client terminal (claim 4, 18 and 19). See abstract, Figs. 3 and 4, and Column 3, line 65 through Column 4, line 52. However, Engbersen did not specifically mention a station/device having a playback module for playing information stored at memory or storage of the station/device. However, for a device to have a playback module for playing back stored information was well known in the art at the time the applicant's invention was made. Kaufman disclosed an Internet audio application having voice memory unit and a playback module to play recorded voice information therein. See ABSTRACT, Figure 2 and Column 4, Lines 36-58.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to take the teachings of Engbersen related to determination of available bandwidth and have modified Jawahar related to establishing a voice connection between devices, so that uploading information from a remoter server to a client terminal could have been deferred or carried out based on the determined available bandwidth. Further it would have been obvious to take the

teachings of Kaufman related to a memory unit and playback module in a device or station and have modified the combined teachings of Engbersen and Sassin by integrating a playback module in order to play audible information stored in a station.

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to Applicant's disclosure.

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, THIS ACTION IS MADE FINAL. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

13. Any inquiry concerning this communication or earlier communication from the examiner should be directed to Yemane Gerezgiher whose telephone number is 703-

305-4874. The examiner can normally be reached on Monday- Friday from 9:00 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful. The examiner's supervisor, William Cuchlinski, can be reached at (703) 308-3873.

Yemane Gerezgiher
AU 2144

WILLIAM A. CUCHLINSKI, JR.
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100